

### **REMARKS**

Applicant respectfully requests reconsideration. Claims 39-41 were previously pending in this application. By this amendment, claim 39 is currently amended, no claims are canceled, and no new claims are added. As a result, claims 39-41 remain pending for examination, with claim 39 being an independent claim. No new matter has been added.

Claim 39 is currently amended to substitute "homo-multimeric anti-PSGL-1 antibody" for "multimeric compound", consistent with the previous version of claim 39, and to specify that the homo-multimeric anti-PSGL-1 antibody is selected based on its ability both to bind specifically to PSGL-1 on the surface of an activated T cell and to induce apoptosis of the activated T cell. Support for this amendment can be found, for example, in the passage entitled "Screening Assays for Compounds that Modulate PSGL-1 Function" spanning pages 19-21 of the specification, particularly at page 21, lines 23-26. Similar support can be found in the corresponding passage spanning pages 12-15 of priority application USSN 10/051,497.

### **Priority**

Applicant acknowledges that the Examiner has accorded the claims in the instant application priority of the filing date of USSN 10/051,497, filed January 18, 2002.

### **Withdrawal of Provisional Obviousness-Type Double-Patenting Rejection**

Applicant thanks the Examiner for withdrawing the previous provisional rejection under the judicially created doctrine of obviousness-type double patenting over claims 9-10 of U.S. Patent Application Serial No. 11/125,837.

### **Rejections Under 35 U.S.C. §103**

The Examiner rejected claims 39-41 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0002450 to Lazarovits et al. ("Lazarovits") and/or U.S. Patent Application Publication No. 2004/0001839 to Levanon et al. ("Levanon 2004") "in view of the well known convention in the art at the time the invention was made to place therapeutic components, including therapeutic antibodies, in a kit for convenience and

economy,” as evidenced by U.S. Patent No. 6,348,581 to Anderson et al. (“Anderson”) and/or U.S. Patent No. 6,884,619 to Hockfield et al. (“Hockfield”), and as further evidenced by the Lin 132 Declaration filed February 1, 2007, in priority application USSN 10/051,497, Example 10 of the instant specification, and U.S. Patent Application Publication No. 2005/0152906 to Levanon et al. (“Levanon 2005”).

An invention that would have been obvious to a person of ordinary skill at the time of the invention is not patentable under 35 U.S.C. §103(a). Obviousness is a question of law based on underlying factual inquiries. The Supreme Court has set out the framework for the objective analysis for determining obviousness in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) (“*Graham*”), recently reaffirmed in *KSR International Co. v. Teleflex Inc., et al.*, 550 U.S. 398, 82 USPQ2d 1385 (2007) (“*KSR*”). The factual inquiries informing this analysis are (A) determining the scope and content of the prior art; (B) ascertaining the differences between the claimed invention and the prior art; and (C) resolving the level of ordinary skill in the pertinent art. *Graham*, 383 U.S. 1, 148 USPQ 459 (1966). Objective evidence, sometimes referred to as “secondary considerations,” including commercial success, long-felt but unsolved needs, failure of others, and unexpected results, can supplement the factual inquiries informing this analysis. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. *KSR* 550 U.S. 398, \_\_\_, 82 USPQ2d 1385, 1396 (2007). MPEP 2143.01.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. MPEP 2142. Significantly, any *prima facie* case must account for all features of the claimed invention. *KSR* 550 U.S. 398, 82 USPQ2d 1385 (2007).

Applicant respectfully asserts that the Examiner has not made a *prima facie* case for obviousness because he has not provided any evidence to support the claimed feature “homomultimeric anti-PSGL-1 antibody is selected based on its ability both to bind specifically to PSGL-1 on the surface of an activated T cell and to induce apoptosis of the activated T cell.” Neither Lazarovits nor Levanon 2004 makes any teaching in respect of selecting any antibody

based on its ability to induce apoptosis of an activated T cell. Similarly, neither Anderson nor Hockfield makes any teaching in respect of this claim element. Furthermore, there is nothing in any of these references to lead a person skilled in the relevant art to think to look to see if the KPL1, Y1, or Y17 antibodies disclosed in Lazarovits or Levanon 2004 can induce apoptosis of an activated T cell. The references, even if combined as suggested by the Examiner, do not teach or suggest, i.e., do not account for, all the recited features of the claimed invention and therefore do not render obvious the claimed invention. Accordingly, the Examiner has not made a *prima facie* case for obviousness.

Applicant respectfully submits that the foregoing assertion is not altered by the "further evidence" cited by the Examiner of the Lin 132 Declaration filed February 1, 2007, in priority application USSN 10/051,497, Example 10 of the instant specification, or Levanon 2005. Not one of these references is prior art against the instant claimed invention. As noted above, the Examiner has accorded the claims in the instant application priority of the filing date of USSN 10/051,497, filed January 18, 2002.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 39-41 under 35 U.S.C. §103(a).


**CONCLUSION**

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, the Director is hereby authorized to charge any deficiency or credit any overpayment in the fees filed, asserted to be filed or which should have been filed herewith to our Deposit Account No. 23/2825, under Docket No. A0871.70001US00.

Dated: March 5, 2009

Respectfully submitted,

By 

Alan W. Steele, M.D., Ph.D.

Registration No.: 45,128

WOLF, GREENFIELD & SACKS, P.C.

Federal Reserve Plaza

600 Atlantic Avenue

Boston, Massachusetts 02210-2206

617.646.8000